

Appl. No. 10/003,252

REMARKS/ARGUMENTS

The abstract of the disclosure has been amended so that it does not exceed the maximum length of 150 words.

The Examiner has rejected claims 1-5, 8, 16-18, and 21 under 35 U.S.C. 102(e) as being anticipated by Carberry *et al.* (U.S. Patent No. 6,430,335).

Claim 1 has been amended to further clarify that the controllable switch is "at all times providing an unbroken optical pathway along the first optical path". Support in the description for this amendment may be found at page 16, lines 12-17 of the present application in which it is described that use of an optical 1-by-2 switch has the side effect of interrupting the first optical path. It is also described that the first and second embodiments are preferred due to the risk of potential failure of the 1-by-2 switch to interfere with the data throughput. It is both inherent in and inferable from the description of the first two embodiments of the present invention, and the passage at page 16 referred to above, that according to some embodiments of the invention, the controllable optical switch is "at all times providing an unbroken optical pathway along the first optical path". As such Applicant submits that the amendment to claim 1 is fully supported by the description.

The Examiner has equated the controllable switch of claim 1 with the optical switch 16 of Carberry *et al.* as it is depicted in Figure 2 of Carberry *et al.* The optical switch of Carberry *et al.* is a 3 port switch which is adapted to couple a first input to a single output while simultaneously decoupling a second input from the output, and also is adapted to couple the second input to the output while simultaneously decoupling the first input from the output. Applicant respectfully submits that Carberry *et al.* does not disclose the coupling of an optical switch to a first optical path which is always provided with an unbroken optical pathway. Accordingly, Carberry *et al.* by not disclosing all of the features of claim 1 does not anticipate claim 1, and Applicant respectfully requests the Examiner to withdraw the rejection under 35 U.S.C. 102(e) of claim 1.

With respect to claims 2-5, 8, 16-18, and 21, each of these claims depends from claim 1 and hence include all of the features of claim 1. For at least the reason that Carberry *et al.* does not disclose all of the features of claim 1, Applicant submits that Carberry *et al.* also does not disclose all of the features of claims 2-5, 8, 16-18, and 21 and therefore does not anticipate these claims. Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. 102(e) rejections of claims 2-5, 8, 16-18, and 21.

The Examiner has rejected claims 6-7 and 19-20 under 35 U.S.C. 103(a) as being unpatentable over Carberry *et al.* as applied to claims 1 and 16 and further in view of Yamada *et al.* (U.S. Patent No. 5,337,337).

In support of the rejection under 35 U.S.C. 103(a) of claims 6-7 and 19-20, the Examiner has relied upon the premise that Carberry *et al.* anticipates claims 1 and 16. The Examiner has

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not in the alternative shown that that Yamada *et al.* teaches or suggests all of the features of either claim 1 or claim 16. Applicant has shown above that amended claim 1 is not anticipated by Carberry *et al.* Claim 16 is also not anticipated by Carberry *et al.* since it depends from claim 1. Applicant submits that the Examiner has not shown a *prima facie* case of obviousness against claims 6-7 and 19-20 for at least the reason that the Examiner has not shown that all of the features of these claims, and specifically the recited "unbroken optical pathway" of claim 1, are taught or suggested in the references cited. Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. 103(a) rejections of claims 6-7 and 19-20. Although Applicant refutes the Examiner's allegation that Yamada *et al.* teaches or suggests all of the specific features of claims 6-7 and 19-20, Applicant does not deem that it is necessary to make any further submissions to traverse the Examiner's rejections of claims 6-7 and 19-20 under 35 U.S.C. 103(a).

Applicant notes with appreciation the Examiner's indication that claims 9-15 and 22-28 would be allowable if re-written in independent form including all of the limitations of the base claim and any intervening claims. Applicant has re-written claims 9, 13, 22, and 26, from which remaining claims 10, 11, 12, 14, 15, 23, 24, 25, 27, and 28 depend, into independent form including all of the limitations of the base claim. Claims 22 and 26 have been re-written to further include all of the limitations of intervening claim 2. In accordance with the Examiner's identification of features which are not taught in the prior art of record, Applicant submits that by this amendment, claims 9-15 and 22-28 are now allowable.

Claims 8 and 21 have been amended to correct typographical errors by which the term "first" has erroneously appeared as "fist".

Claims 29 to 33 have been added. Claim 29 is based on claim 1 as amended. More particularly, claim 29 includes all of the limitations of amended claim 1 and recites additional structure of the controllable switch. Claim 29 is allowable for the reasons that amended claim is allowable.

Claim 30 is based on amended claim 9 and includes all the limitations of that claim plus additional structural limitations. As claim 9 is allowable so too is claim 30.

Claim 31 is based on amended claim 13 and includes all of the limitations of claim 13 plus additional structural limitations. Claim 31 is allowable for at least the same reasons that claim 13 is allowable.

Claim 32 is based on amended claim 22 and includes all of the limitations of claim 22 plus additional structural limitations. Claim 32 is allowable for at least the same reasons that claim 22 is allowable.

Claim 33 is based on amended claim 26 and includes all of the limitations of claim 26 plus additional structural limitations. Claim 33 is allowable for at least the same reasons that claim 26 is allowable.

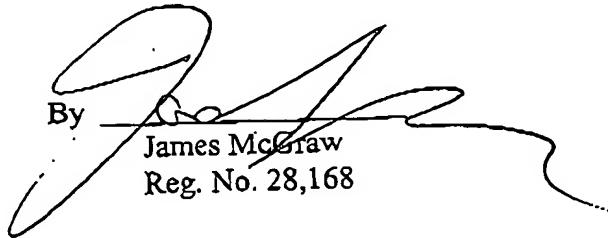
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The additional structural limitations in new claims 29 to 33 are the various inputs and outputs of the various devices shown in Figure 4 for example. The "controlling device" referred to in the new claims is "controlling means 18" of Figures 3 and 4 and the "controllable device" of claims 29, 31 and 33 is the "controllable optical signal blocker 30" shown in Figure 4 and referred to in the specification and in previous claim 9. It is submitted that all of the additional structural limitations are supported by the original disclosure.

The Examiner is respectfully requested to pass this application to allowance but, if there are any outstanding issues, the Examiner is respectfully requested to telephone the undersigned.

Respectfully submitted,

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Date: May 25, 2004

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